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OFFICE OF PETITIONS

In re Application of :
MCSHEFFREY et al. :
Application Number: 10/614,948 : **DECISION ON PETITION**
Filing Date: 07/08/2003 :
Attorney Docket Number: ENGA-0007-P01 :

This is a decision on the petition filed on March 15, 2010, under 37 CFR 1.137(b),¹ to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

¹ Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continuing examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The application became abandoned for failure to submit the issue and publication fees on February 19, 2010, in response to the Notice of Allowance and Fee(s) Due mailed on November 19, 2009, which set a three (3) month statutory period for reply. A Notice of Abandonment was mailed March 8, 2010.

Petitioner has submitted a Request for Continued Examination (RCE), a submission under 37 CFR 1.114 in the form of an IDS, and a RCE fee, as the required reply.

The petition must be dismissed because 37 CFR 1.137(c) states, in part, that in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. However, the issue fee has not been paid, and applicant's fee submission does not authorize the charging of the issue and publication fees, or fees under 37 CFR 1.18.

MPEP 711.03(c) states, in pertinent part, that while the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are incorporated together in 37 CFR 1.137, the statutory provisions for the revival of an application abandoned for failure to timely prosecute and for failure to timely submit the issue fee are mutually exclusive. See Brenner v. Ebbert, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968). 35 U.S.C. 151 authorizes the acceptance of a delayed payment of the issue fee, if the issue fee "is submitted ... and the delay in payment is shown to have been unavoidable." As such, even when an RCE is filed, the issue and publication fees must be paid in order to revive an application abandoned for failure to submit the issue and publication fees.

Accordingly, payment of the issue and publication fees is a prerequisite to revival of the application.

Petitioner should note that if the application is again allowed, the previously paid issue fee and publication fee will be reapplied toward the fees due at that time. See MPEP 1306.

Any renewed petition must be accompanied by payment of the issue and publication fees.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Correspondence may also be filed using the EFS-Web system of the USPTO.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions